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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/568,682

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EXAMINER

MEHTA, HONG T

ART UNIT

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1794

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/568,682	Applicant(s) KO, SUNG KWON	
	Examiner HONG MEHTA	Art Unit 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 February 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>February 17, 2006</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This office action is in response to application 10/568,682 filed on February 17, 2006.

Pending claims 1-18 are under examination.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. The phrase Rb1, Rb2, Rb3, Rb5 Rc, Rd, Re, and Rf in claims 1, 13, 17, and 18; and *Panax* species in claim 5 are enclosed in parenthesis. It is unclear if the phrase is a positive limitation to the cited claims. Appropriate correction is required.

4. The term "it" in claim 1, line 4; claim 10, line 3; claim 11, line 3; and claim 12, line 3 is vague. It is not clear to what "it" is in the claim, ginseng extract, vinegar, ginsenosides, combination of vinegar and ginseng? Clarification is necessary.

5. A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then

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narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 11 recites the broad recitation “temperature lower than 90°C”, and the claim also recites “temperature lower than 70°C” which is the narrower statement of the range/limitation. It is not clear if applicant’s temperature range lower than 90°C, or lower than 70°C, or between 70°C to 90°C. Appropriate correction is required.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

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8. **Claims 1-10, and 12-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ogawa (JP 403083565 A, Abstract) and in view of Choi (KR 2001047790 A, Abstract) and Kang et al. (KR 100228510, applicant submitted art, Machine Translation) and further evidenced by Barrett (Chemistry in Your Environment, 1994).**

9. **Regarding claims 1, 3, 4, 10, 12-17 and 18** Ogawa discloses a method of making health drink, "ginseng preparation" comprising alcohol-extracted concentrated ginseng extract and vinegar and allowed to stand for a fixed period of time to achieve a palatable taste ('565, Abstract).

10. Ogawa does not disclose the heating step of the ginseng extract and vinegar mixture. Ogawa is silent regarding the ginseng extract with ginsenosides; amount of ginsenoside Rg3 to total ginsenosides and the pH vinegar as cited.

11. However, Kang et al. discloses a process to obtain a ginseng extract comprising ginsenosides (Abstract) by extraction with organic solvent including alcohol and subjecting ginseng "it" for 0.5 hours to 20 hours in presence of acid. Kang et al. clearly teaches heat exposure and time of ginseng plant in high temperature of 110°C to 180°C for 0.5 hours to 20 hours to increase the content of ginsenoside components in ginseng extract ('510, page 2; para. 1-8; pg. 3). Furthermore, it is well known that vinegar has a pH value in a range of pH 2.8 as evidenced by Barrett (pg. 29). It would have been obvious to one of ordinary skill in the art to use heating parameters of ginseng to produce ginseng extract with increased inherent ginsenoside components as taught by

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Kang et al. in the process of Ogawa to produce a health drink with desirable health benefits.

12. Additionally, Choi discloses a method of making a functional vinegar composition comprising extracts of ginseng and white vinegar to contribute to health improvement. Choi discloses ginseng in volume of 30% in the vinegar composition ('790, Abstract). It would have been obvious to one of ordinary skill in the art to use the amount of Choi's ginseng extract in Ogawa's process of making ginseng extract and vinegar composition because Choi clearly teaches the amount of ginseng extract to vinegar is a successful amount. It would have been obvious to combine Kang's process of extraction ginseng extract and Choi's amount of ginseng extract into Ogawa's process of making health drink for a desirable health benefit upon consumption.

13. **With respect to claims 1, 2, 13, 14, and 15** as Ogawa modified by Kang et al. and Choi uses like materials, ginseng and vinegar; and in a like manner, heating exposure of temperature and time as claimed, it would therefore be expected that the composition of ginsenosides will have the same characteristics claimed, particularly the percentages, absent a showing otherwise.

14. **With respect to claims 10 and 12**, Kang et al. clearly teaches heat exposure and time of ginseng plant in high temperature of 110°C to 180°C for 0.5 hours to 20 hours to increase the content of ginsenoside components in ginseng extract ('510, page 2; para. 1-8; pg. 3). Kang et al. overlaps the instant cited claims, however it would have been obvious to one of ordinary skill to adjust the temperature and time exposure to extract a desirable amount of ginsenosides content in ginseng extract as taught by

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Kang et al. It would have been obvious to one of ordinary skill in the art to select any portions of the disclosed ranges including the instantly claimed ranges from the ranges disclosed in the prior art references, particularly in view of the fact that; "The normal desire of scientists or artisans to improve upon what is already generally known provides the motivation to determine where in a disclosed set percentage ranges is the optimum combination of percentages" *In re Peterson* 65 USPQ2d 1379 (CAFC 2003).

15. **Regarding claims 5 and 6**, Kang et al. discloses plant leaves and tissue of Korean ginseng, American ginseng, Sanqi ginseng and Japanese ginseng ('510, page 6, paragraph 2).

16. **Regarding claims 7, 8 and 9**, Ogawa discloses brewing brown rice vinegar ('565, Abstract).

17. **Regarding claim 16**, Choi discloses 70 volume % of vinegar comprising citric acid. Choi does not disclose the amount of citric acid; however the percentage ranges of acid in low pH vinegar composition. It would have been obvious to adjust the amount of citric acid to low pH levels in a vinegar composition for a desired sourness depends upon one's individual preferences as this is routinely in food. The manipulation of the product for the application is specific would be well within the purview of one of ordinary skill in the art.

18. **Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ogawa (JP 403083565 A, Abstract), Choi (KR 2001047790 A, Abstract), Kang et al. (KR 100228510, applicant submitted art, Machine Translation) and evidenced by**

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Barrett (Chemistry in Your Environment, 1994) and further in view of Ahn (KR 2001055013 A).

19. Ogawa, Choi, and Kang et al. discloses the claimed invention as discussed above in claim 1. However Ogawa did not disclose heating step as cited in claim 11.

20. However, Ahn discloses a method of producing vinegar with red ginseng. Ahn discloses a sterilizing step by heating the ginseng vinegar at 60°C to 80°C. It would have been obvious to one of ordinary skill in the art to use Ahn's heating step in Ogawa's process of making ginseng/vinegar composition to ensure food product is properly sterilized from harmful bacteria.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to HONG MEHTA whose telephone number is (571)270-7093. The examiner can normally be reached on Monday thru Thursday, from 7:30 am to 4:30 pm EST..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jennifer McNeil can be reached on 571-272-1540. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Htm

/Jennifer McNeil/
Supervisory Patent Examiner, Art Unit 1794